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PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICANT	:	HAROLD C. VOGEL, ET AL.
SERIAL NUMBER	:	10/679,229
FOR	:	MEMORIAL CREATED FOR CREMATION REMAINS AND PROCESSES FOR MAKING SAME
FILED	:	OCTOBER 3, 2003
ART UNIT	:	3677
EXAMINER	:	WILLIAM L. MILLER

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

TO: COMMISSIONER OF PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

ATT: BOARD OF APPEALS

SIR:

Responsive to the Notification of Non-Compliant Appeal Brief dated March 1, 2007, enclosed please find three new copies of the Appeal Brief. The changes to the Appeal Brief currently submitted occur in V. Summary of Claimed Subject Matter, in which the elements of independent Claims 1 and 7 have been mapped by reference to page and line numbers in the specification.

Applicant believes that this substitute Appeal Brief is in

Compliance with the Requirements of the Notification of Non-Compliant Appeal Brief.

Respectfully submitted,

HAROLD C. VOGEL, ET AL. - APPLICANT

By: _____ 3/3/07

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SIR:

This is an appeal from the Office Action (final) dated August 15, 2006.

I. REAL PARTY IN INTEREST

Harold C. Vogel, Et Al., the named inventors, are the real parties in interest.

II. RELATED APPEALS AND INTERFERENCES

None

III. STATUS OF ALL CLAIMS

Claims 1 through 12 are pending in the application. Claims 1 through 12 stand rejected and are the appeal claims.

IV. STATUS OF ALL AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

No amendments were filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A memorial for deceased humans or animals in which the cremated residue or ash (Spec., Page 3, Lines 5-12)(Claim 1, Line 2)(Claim 7, Lines 2-3) is blended or mixed with particulate glass (Page 3, Lines 14-19)(Claim 1, Lines 3-4)(Claim 7, Lines 3-4), the mixture being heated to form a liquid pool of glass with the cremation residue or ash dispersed (Page 5, Lines 5-15)(Claim 7, Lines 5-6), infused and/or absorbed therein, the molten glass and ash being removed from the heat source after a suitable time period and transferred to a mold (Page 5, Lines 21-23)(Page 6, Lines 6-7)(Claim 7, Line 6) in the shape of the memorial, the mold allowed to cool until the memorial sets, the memorial then removed from the mold and reheated in an annealing oven (Page 6, Line 24 - Page 7, Line 2) at a suitable temperature (Page 7, Line 2) for a suitable time so as to eliminate possible cracking and scoring, the memorial once removed from the annealing oven can be further cut, polished, faceted, engraved or the like (Page 7, Lines 16-20). The initial mixture of particulate glass and cremation residue and

ash can be further combined with a coloring agent (Page 4, Lines 21-26) if so desired before heating or before transfer to the memorial mold.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Are Claims 7-12 indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention pursuant to 35 U.S.C. §112?

Does the Yardley reference, U.S. #2002/0025392 render Claims 1, 2, 3-5, 11 and 12 anticipated under 35 U.S.C. §102(e)?

Does the Yardley reference U.S. #2002/0025392 render Claims 3, 4, 9, and 10 obvious under 35 U.S.C. §103(a)?

VII. ARGUMENT

Applicant respectfully submits that independent Claim 7 and the claims depending there from, Claims 8-12 are not indefinite under 35 U.S.C. §112. Independent Claim 7 is an article claim as treated by the Examiner and is directed to the glass form of the "memorial product".

Claims 1, 2, 5-8, 11 and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by Yardley, publication number 2002/0025392.

The Yardley reference is directed to a permanent memorial created from cremation remains. Applicant's independent Claims 1 and 7 as pending make it clear that Applicant's memorial product comprises bone ash in combination with ground art glass

or ground sheet glass.

Yardley requires the bone ash in combination with a glass forming additive and a glass modifying additive. The glass modifying additive being aluminum oxide, titanium dioxide or zinc peroxide. Applicant requires no such glass modifying additive. Indeed, in paragraphs 0014, 0015, and 0016, Yardley sets for his glass formers, his glass modifiers and his flux components.

Still further, in paragraph 0018, Yardley sets forth more components required in order to obtain the memorial product of his invention. Still further, Yardley makes it clear in paragraph 0023 and 0024 that these modifying glass additives are a requirement. Indeed, in each and every example that Yardley sets forth, these components are present, together with the frit composition. (See paragraphs 0029 through 0093).

Applicant has simplified the production of a memorial product from that disclosed by Yardley. Applicant can utilize ground art glass or ground sheet glass in combination with bone ash to form the memorial product in its simplest form. Depending upon the ground art glass or ground sheet glass utilized, color may be imparted to the memorial product or color may be added to the memorial product. Therefore, Applicant's memorial product does not contain all of the elements as required by Yardley.

In W.L. Gore and Associates v. Garlick, Inc., 469 US 851(1984), the Federal Circuit states that "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. It is not enough however that the prior art reference disclosed all of the claimed elements in isolation. Rather as stated by the Federal Circuit, "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik Gmbh v. American Hoist and Dairy Co., 221 USPQ 481 (Fed Cir. 1984). Further, under 35 U.S.C. §102 anticipation requires that the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. Further, the Federal Circuit has added that anticipation determination is viewed from one of ordinary skill in the art. Scripps Clinic and Research Foundation v. Genentech, Inc., USPQ 2nd 1001 Fed. Cir. 1991. Still further the court has held that with respect to inherency, it may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is insufficient. The missing element or function must necessarily result from the prior art references. In re Oelrich 212 USPQ 323 (CCPA 1981).

By examining the various elements of the decisions, a prima facie case of anticipation is established when the Examiner provides 1) a single reference; 2) that teaches or enables; 3) each of the claimed elements arranged as in the claim; 4) expressly or inherently; and 5) as interpreted by one of ordinary skill in the art. The absence of one of these elements defeats the prima facie case of anticipation.

Clearly Yardley fails as a reference in that it does not teach or enable the memorial product of Applicant's invention, and does not have each of the claimed elements arranged as in the claim. Applicant therefore respectfully submits that Yardley must fail as a reference under 35 U.S.C. §102.

A claimed invention is obvious if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." In order to determine obviousness, four factual inquiries are required under the tenets of *Graham v. John Deere* 148 USPQ 459 (1966). Those inquiries concern (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of non-obviousness which in case law is often said to include commercial success, long felt but unresolved need, failure of others, copying and unexpected

results.

When issues involving the instance arise during the prosecution or examination of the application, it is incumbent upon the Patent and Trademark Office to present a prima facia case of unpatentability. *In re Glaug* 62 USPQ 2nd 1151 (Fed. Cir. 2002). If the prima facia case is not made, the Applicant is entitled to a patent. If the prima facia case is made, the burden shifts to the Applicant to come forward with evidence and/or arguments supporting patentability. After a prima facia case of obviousness has been made and rebutted, all evidence is considered anew and a determination on the entirety of the record is made by a preponderance of the evidence.

In order to establish a prima facia case of obviousness, one must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine or otherwise modify the relevant teachings of the references. *In re Fine* 5 USPQ 2nd 1596 (Fed. Cir. 1988).

A prima facia case of obviousness is rebutted if the Applicant can show that the art in any material respect taught away from the claimed invention and that there is no suggestion to combine if a reference teaches away from its combination with another source. *Tec Air* 52 USPQ 2nd 1298. Where there is an express or implicit determination of obviousness, there must be

particular findings related to the determination. Broad conclusory statements standing alone are not "evidence". The factual question of motivation is material to patentability and cannot be resolved on subjective believe and unknown authority. *In re Kotsab* supra. *In re Lee* 61 USPQ 2nd 1430 (Fed. Cir. 2002).

There can be no motivation to combine if a reference teaches away from its combination with another source. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference or be led in a direction divergent from the path that was taken by the Applicant, or if it suggests that the line of development flowing from the reference and disclosure is unlikely to be productive of the results sought by the Applicant. For example if, when combined, the references would produce a seeming inoperative device, then they teach away from the combination. There can be no motivation to modify a prior art device if the modification would render the device inoperable for its intended purpose. *Tec Air* supra and *In re Dance* 48 USPQ 2nd 1635 (Fed. Cir. 1998).

Still further the mere fact that references may be modified or combined does not make the modification or combination obvious unless the prior art suggested the desirability of the modification or combination. *In re Fitch* 23 USPQ 2nd 1780 (Fed.

Cir. 1992).

A prima facie case of obviousness is established when the Examiner provides 1) one or more references; 2) that were available to the inventor; 3) that teach; 4) a suggestion to combine or modify the references; and 5) the combination or modification of which would have been sufficient to have made the claimed invention obvious to one of ordinary skill in the art. The failure to establish all of the elements will prevent the prima facie case of obviousness from being established. In re Lalu, 223 USPQ 1257 (Fed. Cir., 1984); In re Fritch, 23 USPQ 2nd 1789 (Fed. Cir., 1992).

Applicant respectfully submits that Yardley is inappropriate as a reference under 35 U.S.C. §103 as rendering Applicant's claims obvious. It is clear from all of the examples given by Yardley, that he was not able to obtain a suitable memorial product without utilizing combined glass forming additives and glass modifiers which are not required not taught by Applicant in his application. Applicant therefore respectfully submits that Yardley is an inappropriate reference under 35 U.S.C. §103.

Appellant therefore respectfully submits that the combination of references relied upon by the Examiner fails to make a prima facia case of obviousness under 35 U.S.C. §103 and therefore Appellant requests this Honorable Board to reverse the

finding of the Examiner and allow the pending claims.

Respectfully submitted,

HAROLD C. VOGEL, ET AL. - APPLICANT

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VIII. CLAIMS APPENDIX

1. A memorial product created for the cremation remains of a human or animal comprising a mixture of bone ash of the deceased human or animal and ground art glass or ground sheet glass.

2. A memorial product in accordance with Claim 1 wherein said ground art glass or said ground sheet glass can be colored or transparent.

3. The memorial in accordance with Claim 1 wherein the bone ash is in a particulate size of no greater than .020 mesh.

4. The memorial product in accordance with Claim 1 wherein said ground art glass or said ground sheet glass is present in a particulate size of .062 mils.

5. The memorial product in accordance with Claim 1 wherein a colorant additive is introduced into said mixture.

6. The memorial product in accordance with Claim 1 wherein the bone ash is present with said ground art glass or said ground sheet glass in an amount no greater than 40% by weight.

7. A memorial product containing the cremation remains of a human or animal, said memorial product comprising a mixture of bone ash of the deceased human or animal; ground art glass or a mixture of ground sheet glass, said mixture of bone ash and ground art glass or ground sheet glass being heated to form a glass melt, said glass melt being poured into a mold and

hardened into a predetermined glass form.

8. A memorial product in accordance with Claim 7 wherein said ground art glass or said ground sheet glass can be colored or transparent.

9. The memorial in accordance with Claim 7 wherein said bone ash is in a particulate size of no greater than .020 mesh.

10. The memorial product in accordance with Claim 7 wherein said ground art glass or said ground sheet glass is present in a particulate size of .062 mils.

11. The memorial product in accordance with Claim 7 wherein a colorant additive is introduced into said mixture.

12. The memorial product in accordance with Claim 7 wherein said bone ash is present with said ground art glass or said ground sheet glass in an amount no greater than 40% by weight.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.